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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,699	11/15/2001	Jean-Claude Kucza		7173

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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,699

Applicant(s)

REMOND ET AL.

Examiner

George P Wyszomierski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: ____

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a process, classified in class 148, subclass 523.
- II. Claim 8, drawn to a product, classified in class 428, subclass 654.

2. The inventions are distinct, each from the other because:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as by continuously casting a core alloy to a desired thickness, i.e. without the hot or cold rolling steps of Invention I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Susan McBee, attorney of record, on January 28, 2003 a provisional election was made with oral traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claim 8 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Claims 1, 2, 5 and 6 are objected to because of the following informalities.

Appropriate correction is required.

a) In the last line of claim 1, "100" should be changed to --10%--.

b) In claim 2, it is unclear whether Applicant's intent is to claim less than "0.01%" as presently drafted, or "0.1%" as stated at page 7, line 8 of the specification.

c) In claim 5, line 2, "80" should be changed to --8%--.

d) In claim 6, line 2, the numeral "5" should be deleted.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sontgerath et al. (U.S. Patent 6,294,272) in view of either Merchant et al. (U.S. Patent 4,517,034) or Papich et al. (U.S. Patent 5,476,725).

Sontgerath discloses a process for producing an aluminum alloy core for use in a brazing sheet which includes the steps of casting the desired alloy, homogenizing at a time and temperature as presently claimed (see Sontgerath column 6, lines 39-42), cladding a second alloy to the core alloy where the second alloy has a silicon content as recited in instant claim 3

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(see Sontgerath column 7, lines 1-3), hot rolling, cold rolling, and annealing at a temperature as presently claimed (see Sontgerath column 7, line 51).

Sontgerath differs from the claimed invention in that Sontgerath does not disclose a strain hardening step as required by the instant claims, and the alloy used in Sontgerath contains a higher percentage of chromium and zirconium than that used in the claimed process. These differences are not seen as resulting in a patentable distinction between the prior art and the claimed invention because:

a) The disclosures of Merchant and Papich et al. indicate it to be conventional in the art to strain harden 3000 series aluminum alloys which have been cast, homogenized, hot and cold rolled and annealed; see Merchant column 1, lines 22-59 or Papich column 2, lines 8-26. In particular, the Papich reference is drawn to the production of alloys for use in making brazed assemblies, i.e. the same intended use as those of Sontgerath. Thus, to incorporate a final strain hardening step into the process of Sontgerath would have been considered obvious by a person of ordinary skill in the art.

b) The instant claims are drawn to a process of manufacture, and the actual process steps used by Sontgerath are analogous to those presently claimed, regardless of the alloy composition. It is further noted that the Sontgerath alloys are aluminum alloys containing amounts of silicon, iron, copper, manganese, magnesium and titanium which significantly overlap the alloys used in the claimed process (note particularly alloy no. 6 in Table 1 of Sontgerath), and one of ordinary skill in the art would expect to achieve success in applying similar process steps as done by Sontgerath to alloys containing differing amounts of minor elements.

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Consequently, the disclosure of Sontgerath, together with those of Merchant et al. or Papich et al., would have taught the presently claimed invention to a person having ordinary skill in the art.

7. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 15 and 21 of U.S. Patent No. 6,451,453 in view of either Merchant et al. or Papich et al. The above noted claims of the '453 patent recite a process for making a strip for use in a brazed heat exchanger made of an alloy substantially overlapping that of the instant claims, with the exception that the '453 claims do not recite the strain hardening step of the instant claims. The Merchant and Papich patents indicate it to be conventional in the art to subject 3000 series aluminum alloys (i.e. alloys similar to those used in the process of the '453 claims) to a final strain hardening step. Because one of ordinary skill in the art, given the teachings of Merchant or Papich, would have included a final strain hardening step after the process as claimed in the '453 patent, the presently claimed process cannot be said to be patentably distinct from that as recited in the '453 claims.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


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9. The remainder of the art cited on the enclosed PTO-892 and 1449 forms is of interest.

This art is held to be no more relevant to the claimed invention than the art as applied in the rejections, supra.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. The fax phone number for this Group is (703) 872-9310 for all correspondence except for After Final amendments in which case the Fax number is (703) 872-9311. The Right fax number for this examiner is (703) 872-9039. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW
January 30, 2003